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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of: **Shogo ISHIOKA**

Group Art Unit: 3625

Serial Number: **10/030,098**

Examiner: **Nicholas D Rosen**

Filed: **May 3, 2002**

Confirmation Number: **5721**

For: **INFORMATION SERVICE METHOD, INFORMATION SERVICE  
SYSTEM AND SYSTEM COMPONENT THEREOF**

Attorney Docket Number: **011713**  
Customer Number: **38834**

**SUBMISSION OF APPEAL BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

20 January 2006

Sir:

Applicants submit herewith an Appeal Brief in the above-identified U.S. patent application.

Attached please find a check in the amount of \$250.00 to cover the cost for the Appeal Brief.

If any additional fees are due in connection with this submission, please charge our Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

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Attorney Docket No. 011713  
Serial No. 10/030,098

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**APPEAL BRIEF FOR THE APPELLANT**

Ex parte Shogo ISHIOKA et al. (applicant)

**INFORMATION SERVICE METHOD, INFORMATION SERVICE SYSTEM AND  
SYSTEM COMPONENT THEREOF**

Serial Number: **10/030,098**

Filed: **May 3, 2002**

Appeal No.:

Group Art Unit: **3625**

Examiner: **Nicholas D Rosen**

Submitted by:

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Date: January 20, 2006

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**BRIEF ON APPEAL**

**(I) REAL PARTY IN INTEREST**

The real party in interest is **OHT, INC.**, by an assignment recorded in the U. S. Patent and Trademark Office on July 9, 2002 at Reel 012861, Frame 0638.

**(II) RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to Appellant, Appellant's legal representative, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(III) STATUS OF CLAIMS**

Claims 1-11 are pending in the application and are appealed. The appealed claims appear in the Claims Appendix.

**(IV) STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the close of prosecution.

**(V) SUMMARY OF THE INVENTION**

Claim 1 is directed at an information service method for providing information via a network including a first information-processing apparatus and a second information-processing

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apparatus 102. The information service method includes the step of inputting identification information of a product for purchase from a user 101 of said network to the first information-processing apparatus. The information service method also includes the step of inputting an order for a surrogate investigation of said product from said user 101 to said first information-processing apparatus. The information service method also includes the step of transmitting identification information of said user 101, identification information of said product, and an instruction on said surrogate investigation from said first information-processing apparatus to said second information-processing apparatus 102. The information service method also includes the step of storing said user identification information and said product identification information in said second information-processing apparatus 102. The information service method also includes the step of calling said product identification information from said second information-processing apparatus 102 to identify said product so as to conduct a physical investigation of said identified product by an appointed investigation agent 105a. Finally, the information service method also includes the step of providing information obtained from said investigation to said user 101 identified on the basis of said user identification information.

Claim 2 requires that the information service method also includes a step of publishing information for designating a store 104 and information about products dealt by said store 104 on said network 103 including said first and second information-processing apparatuses, wherein said user 101 identifies a product for purchase among said published products.

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Claim 3 requires that the information service method the step of inputting an order for a surrogate investigation includes designating the level of said investigation or a deadline for the answer of said investigation.

Claim 4 is directed at an information service system 100 for providing information via a network 103 comprising a first information-processing apparatus and a second information-processing apparatus 102. The first information-processing apparatus includes a means for acquiring identification information of a product for purchase and an order of a surrogate investigation of said product, from said user 101 of said network 103, and a means for transmitting identification information of said user 101, identification information of said product, and an instruction of said surrogate investigation, to said second information-processing apparatus 102. The said second information-processing apparatus 102 includes a means for storing said user identification information and said product identification information with a certain association therebetween, and a means for providing information about a result of a physical investigation by an appointed investigation agent 105a to said user 101, said investigation being related to said product identified on the basis of said information stored in said storing means.

Claim 5 requires that the acquiring means is operable to acquire the identification information of a product for purchase and the order in parallel with publishing information for

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designating a store 104 and information about products dealt by said store 104 on said network 103 to provide said products to said user 101.

Claim 6 requires that the acquiring means is operable to acquire designated information about the level of said investigation or a deadline for the answer of said investigation from said user 101.

Claim 7 is directed at a server apparatus 102a to be connected to an information-processing terminal via a network 103. The information-processing terminal includes a means for acquiring identification information of a product for purchase and an order for a surrogate investigation of said product, from a user of said network; and a means for transmitting identification information of said user 101, identification information of said product and an instruction of said surrogate investigation, to said server apparatus 102a. The server apparatus comprises a means for storing said user identification information and said product identification information with a certain association therebetween; and a means for providing information about a result of a physical investigation by an appointed investigation agent 105a to said user 101, said investigation being related to said product identified on the basis of said information stored in said storing means.

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Claim 8 requires that a computer readable medium storing a program to be read in and executed on a computer is used to implement the server apparatus 102a.

Claim 9 is directed at an information-processing terminal to be connected to a server apparatus 102a via a network 103. The server apparatus 102a includes a means for storing identification information of a user of said network and identification information of a product for purchase with a certain association therebetween; and a means for providing information about a result of a physical investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means. The information-processing terminal comprises a means for acquiring identification information of a product for purchase and an order for a surrogate investigation of said product, from said user of said network; and a means for transmitting said identification information of said user, said identification information of said product and an instruction on said surrogate investigation, to said server apparatus.

Claim 10 requires a computer readable medium storing a program to be read in and executed on a computer is used to implement the information-processing terminal.

Claim 11 is directed at an information service method including the step of acquiring identification information of an applicant for purchase and of a product for purchase designated

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by said applicant via a network 103. The information service method also includes the step of storing said acquired identification information. The information service method also includes the step of acquiring an order for a surrogate investigation of said product from said applicant via said network 103. Finally, the information service method includes the step of providing information obtained from a physical investigation of said product by an appointed investigation agent 105a, to said applicant on a basis of the stored identification information via said network 103.

#### **(VI) ISSUE TO BE REVIEWED ON APPEAL**

Whether claims 1, 2, 4, 5, 7, 9 and 11 are unpatentable under 35 U.S.C. §103(a) over Hulls in view of the Pat Ludwick article, and whether claims 3, 6, 8 and 10 are unpatentable under 35 U.S.C. §103(a) over Hulls, the Pat Ludwick article, and Official Notice.

#### **(VII) ARGUMENT**

##### **Discussion of the Cited Art**

Hulls teaches the use of an agent involved in aiding buyers and sellers with listing and searching items for sale. In other words, the agent helps the buyer and seller to contact each other. Please see, for instance, abstract and paragraph [0031]. As illustrated in Figure 1, the agent's only contact with other parties is electronic. Also see for instance Figures 11, 12, 14, 15,

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17, and 23, and associated text. These Figures illustrate buyers and sellers contacting an agent to help them purchase or sell a particular item. There is no discussion of a physical investigation by the agent, or the need for a physical investigation.

The Pat Ludwick article discusses a company called "Auto Critic" which sells its services of auto appraisals by licensed mechanics. Although the article states that the inspections are done at any location "directed by the customer," there is no disclosure of any electronic communication over a network between any of the parties.

### **The Examiner's Office Notice is Misdirected**

In the Office Action dated February 15, 2005, the Examiner took Official Notice of the designation of a deadline for purchasing or finding a desired product and of the use of computer readable media to store programs to cause computers to carry out their intended functions. In the Response filed on May 16, 2005, Appellants requested that the Examiner provide evidence of these concepts.

In the Office Action dated July 20, 2005, the Examiner has cited the Gerstner article, "Temporal Price Dispersion" and the Microsoft Press Computer Dictionary to support the holding of Official Notice. In the Response filed on October 17, 2005, Appellants respectfully argued against the Examiner's Official Notice of the designation of a deadline for purchase of a product.

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The claims recite the designation of “a deadline for the *answer of said investigation.*”

Despite this, the Office Action takes Official Notice of the designation of “a deadline for *finding or purchasing a desired product*” by citing an article regarding Christmas shopping. Appellants respectfully argue that a deadline for the *answer of an investigation* is different from the deadline for *finding or purchasing a product*, since they are different actions.

**Claims 1, 2, 4, 5, 7, 9, and 11 are patentable over Hulls and the Pat Ludwick article**

As in the Office Action dated February 15, 2005, the Office Action dated July 20, 2005 argues that Hulls discloses the information service method as claimed. In the Amendment filed on May 16, 2005, claim 1 was amended to recite the step of:

calling said product identification information from said second information-processing apparatus to identify said product so as to conduct a physical investigation of said identified product by an appointed investigation agent (emphasis added).

Claim 4 was amended to recite:

means for providing information about a result of a physical investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means (emphasis added).

Claim 7 was amended to recite:

means for providing information about a result of a physical investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means (emphasis added).

Claim 9 was amended to recite:

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means for providing information about a result of a physical investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means (emphasis added).

Claim 11 was amended to recite the step of:

providing information obtained from a physical investigation of said product by an appointed investigation agent, to said applicant on a basis of the stored identification information via said network (emphasis added).

As noted above, Hulls only discloses electronic contact between the parties. The Office Action dated July 20, 2005 states that “Hulls does not disclose that the investigation is a physical investigation but it is well known [to] conduct physical investigations as taught by the ‘Pat Ludwick article.’”

In Hulls, the agent is involved in aiding buyers and sellers with listing and searching items for sale. In other words, the agent helps the buyer and seller to contact each other. Please see, for instance, abstract and paragraph [0031]. Hulls contains no disclosure or suggestion of an agent physically inspecting a product, or the need for such a physical investigation.

In fact, it is evident from Hulls that the agent does not have any physical contact with other parties or their goods for sale. Hulls specifically discusses the purposes of the agent in paragraphs [0012] to [0019]. This role includes mediating a transaction, allowing parties not located on the network to buy or sell goods, and to “prevent overloading individual transaction participants with excessive numbers of communications.” Paragraph [0017]. These activities are also illustrated in the Figures, which show example screenshots of the method and system.

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The Pat Ludwick article discusses a company called “Auto Critic” which sells its services of auto appraisals by licensed mechanics. The article contains no suggestion or disclosure of the use of a network. Although the article states that the inspections are done at any location “directed by the customer,” there is no disclosure of an information-processing apparatus, a storing means, or a network, as required by the independent claims.

Appellants respectfully submit that the combination of the Hulls application and the Pat Ludwick article would not have been obvious to one having ordinary skill in the art at the time of invention. Hulls contains no disclosure or suggestion of the use of, or need for, a physical investigation of a product. Furthermore, the disclosure in Hulls of no physical contact between parties actually teaches away from the use of or need for a physical inspection. The agent in Hulls is simply an *intermediary*. It would be impractical or impossible for the agent in Hulls to conduct a physical investigation of the goods for sale, because such an investigation would be time consuming. Because the method and system of Hulls is internet-based, the goods may be located geographically far from the agent, making an investigation impractical. Furthermore, Hulls makes no reference to the quality or condition of the goods for sale, other than the seller’s comments.

Additionally, the Pat Ludwick article contains no disclosure or suggestion of the use of an information-processing apparatus, a storing means, or a network. The Pat Ludwick article does not disclose how the investigation is ordered and reported, whether by telephone call, mail-in request, or personal visit. Since the cited art does not contain a suggestion or motivation to

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combine the references, Appellants respectfully argue that combining the system for commercial transaction of Hulls with the physical investigations of a product of the Pat Ludwick article would not have been obvious to one having ordinary skill in the art at the time the invention was made.

Furthermore, Appellants respectfully argue that even if Hulls and the Pat Ludwick article were combined, such a combination would not provide all the features of the independent claims. It is well settled that:

"A claim is anticipated only if each and every element *as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference." *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1567, 7 USPQ2d 1057 (Fed. Cir. 1988)."

In Hulls, the agent is involved in aiding buyers and sellers with listing and searching items for sale. In other words, the agent helps the buyer and seller to contact each other, and does not perform an investigation. The Pat Ludwick article only discloses a physical inspection of an item, without regard to how this inspection is ordered or the results reported. Thus a combination of the references would teach only a system in which an *agent* aids the buyer and seller in listing and searching the product via a computer network, while an *inspector* performs an investigation of a product. Because the Pat Ludwick article does not disclose the use of hardware used to order or report the investigation, the combination of Hulls and the Pat Ludwick article result in an investigation which is not ordered via a computer network and an investigation where the obtained information is provided without using a computer network. Therefore, the combination of Hulls and the Pat Ludwick article does not teach:

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calling said product identification information from said second information-processing apparatus to identify said product so as to conduct a physical investigation of said identified product by an appointed investigation agent,

means for providing information about a result of a physical investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means,

or

providing information obtained from a physical investigation of said product by an appointed investigation agent, to said applicant on a basis of the stored identification information via said network.

**Claims 3, 6, 8 and 10 are patentable over Hulls, the Pat Ludwick article, and Official Notice**

The Office Action dated July 20, 2005 rejects the dependent claims on the basis of Official Notice directed towards the obviousness of deadline for investigation and the use of a computer-readable medium. In response, Appellants respectfully argue that claims 8 and 10 are patentable due to their dependency on independent claim 7.

With regard to claims 3 and 6, Appellants additionally argue that the combination of Hulls, the Pat Ludwick article, and the Official Notice does not establish *prima facie* obviousness. As discussed above, the Office Notice with regard to deadlines is misplaced, as the claims are directed at a deadline for the *answer of an inspection*, rather than a deadline for *purchasing or finding a product*.

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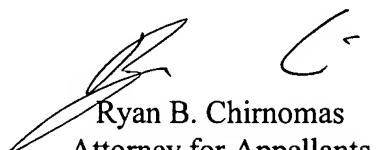
**(VIII) CONCLUSION**

For at least the foregoing reasons, the Examiner has failed to raise a prima facie rejection of the claims. The Honorable Board is respectfully requested to reverse the rejection of the Examiner.

If this paper is not timely filed, appellants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 50-2866, along with any other additional fees that may be required with respect to this paper.

Respectfully submitted,

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## **CLAIMS APPENDIX**

Claim 1. An information service method for providing information via a network including a first information-processing apparatus and a second information-processing apparatus, said information service method comprising steps of:

    inputting identification information of a product for purchase from a user of said network to said first information-processing apparatus;

    inputting an order for a surrogate investigation of said product from said user to said first information-processing apparatus;

    transmitting identification information of said user, identification information of said product, and an instruction on said surrogate investigation from said first information-processing apparatus to said second information-processing apparatus;

    storing said user identification information and said product identification information in said second information-processing apparatus;

    calling said product identification information from said second information-processing apparatus to identify said product so as to conduct a physical investigation of said identified product by an appointed investigation agent; and

    providing information obtained from said investigation to said user identified on the basis of said user identification information.

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Claim 2. An information service method as defined in claim 1, which further includes a step of publishing information for designating a store and information about products dealt by said store on said network including said first and second information-processing apparatuses, wherein said user identifies a product for purchase among said published products.

Claim 3. An information service method as defined in claim 1 or 2, wherein said step of inputting an order for a surrogate investigation includes designating the level of said investigation or a deadline for the answer of said investigation.

Claim 4. An information service system for providing information via a network, said information service system comprising: a first information-processing apparatus and a second information-processing apparatus,

    said first information-processing apparatus including:

        means for acquiring identification information of a product for purchase and an order of a surrogate investigation of said product, from said user of said network, and

        means for transmitting identification information of said user, identification information of said product, and an instruction of said surrogate investigation, to said second information-processing apparatus; and

    said second information-processing apparatus including:

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means for storing said user identification information and said product identification information with a certain association therebetween, and

means for providing information about a result of a physical investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means.

Claim 5. An information service system as defined in claim 4, wherein said acquiring means is operable to acquire the identification information of a product for purchase and the order in parallel with publishing information for designating a store and information about products dealt by said store on said network to provide said products to said user.

Claim 6. An information service system as defined in claim 4 or 5, wherein said acquiring means is operable to acquire designated information about the level of said investigation or a deadline for the answer of said investigation from said user.

Claim 7. A server apparatus to be connected to an information-processing terminal via a network, said information-processing terminal including:

means for acquiring identification information of a product for purchase and an order for a surrogate investigation of said product, from a user of said network; and

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means for transmitting identification information of said user, identification information of said product and an instruction of said surrogate investigation, to said server apparatus, and wherein

said server apparatus comprises:

means for storing said user identification information and said product identification information with a certain association therebetween; and

means for providing information about a result of a physical investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means.

Claim 8. The server apparatus of claim 7, wherein a computer readable medium storing a program to be read in and executed on a computer is used to implement the server apparatus.

Claim 9. An information-processing terminal to be connected to a server apparatus via a network, said server apparatus including:

means for storing identification information of a user of said network and identification information of a product for purchase with a certain association therebetween; and

means for providing information about a result of a physical investigation by an appointed investigation agent to said user, said investigation being related to said product identified on the basis of said information stored in said storing means, and wherein

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said information-processing terminal comprises:

means for acquiring identification information of a product for purchase and an order for a surrogate investigation of said product, from said user of said network; and

means for transmitting said identification information of said user, said identification information of said product and an instruction on said surrogate investigation, to said server apparatus.

Claim 10. The information processing terminal of claim 9, wherein a computer readable medium storing a program to be read in and executed on a computer is used to implement the information-processing terminal.

Claim 11. An information service method comprising the steps of:

acquiring identification information of an applicant for purchase and of a product for purchase designated by said applicant via a network;

storing said acquired identification information;

acquiring an order for a surrogate investigation of said product from said applicant via said network; and

providing information obtained from a physical investigation of said product by an appointed investigation agent, to said applicant on a basis of the stored identification information via said network.

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**EVIDENCE APPENDIX**

None Presented.

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**RELATED PROCEEDINGS APPENDIX**

No Related Proceedings